

### REMARKS

A final Office Action has been issued in the subject application in which all of the pending claims, i.e., claims 1–4, were rejected under 35 U.S.C. § 103 for obviousness. This AMENDMENT AND RESPONSE is filed with a REQUEST FOR CONTINUED EXAMINATION.

Summarizing the Amendment, the specification has been amended to correct a typographical error, and claim 2 has been amended and new claims 5–20 have been added to more particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1–20 remain in the application.

Reconsideration and reexamination of the subject application in view of the amendments and the following remarks are respectfully requested.

### THE REJECTIONS

The following remarks first address the patentability of the claims and then point out the errors in the Patent Office's rejections.

#### Requirements for Obviousness

The Federal Circuit stated in *In re Oeticker* [977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992)], “[i]f examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” The CCPA interpreted *prima facie* obviousness in *In re Lintner* [458 F.2d 1013, 173 USPQ 560, 562 (C.C.P.A. 1972)] as follows:

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification.

In *In re Rinehart* [531 F.2d 1048, 189 USPQ 143 147 (C.C.P.A. 1976)], the CCPA added that the *prima facie* case requires that the teachings of the reference “appear to have suggested the *claimed subject matter*.” In view of these decisions, a *prima facie* case of obviousness is established when the Patent Office provides:

- a) one or more references

- b) that were available to the inventor and
- c) that teach
- d) a suggestion to combine or modify the references,
- e) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

If any one of these elements is not present, the *prima facie* case of obviousness is not established. In the instant case, it is respectfully submitted that the cited references fail to meet these requirements.

### Claims 1 and 2

Claims 1 and 2 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,528,222 to Moskowitz et al. in view of U.S. Patent No. 5,751,221 to Stanfield et al. Applicant traverses these rejections.

### The Cited References

U.S. Patent No. 5,528,222 to Moskowitz et al. shows an RF ID tag 200 in FIG. 2:

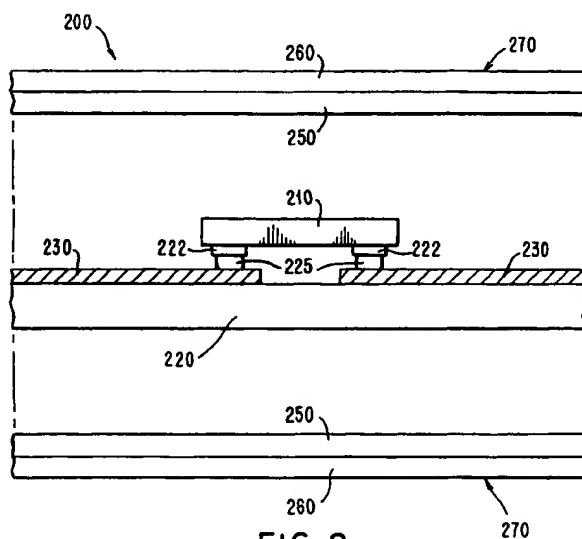
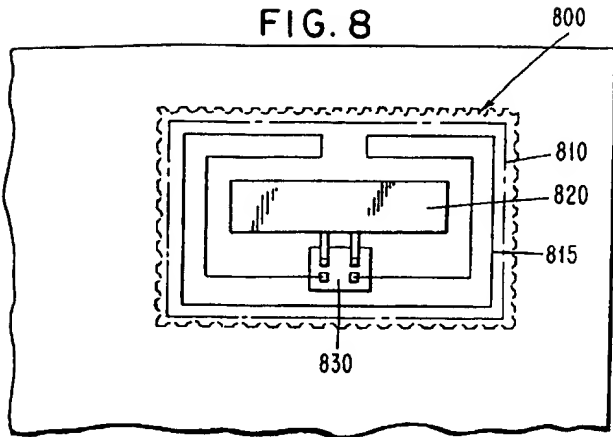


FIG. 2

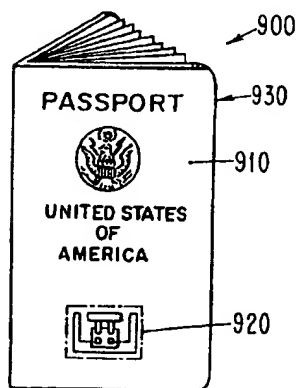
A chip 210 is located on a flexible substrate 220. The chip 210 with bumps 225 on contacts 222 is bonded to an antenna 230 contained on the substrate 220. The package is sealed by thin flexible laminations 270 consisting of a hot-melt 250 such as EVA on the inside and an outer coating 260 of a polymeric material on the outside.

Moskowitz et al. provide examples of how the RF ID tag 200 can be used. For example, in combination with a postage stamp as shown in FIG. 8, in which an RF postage stamp 800 containing a thin RF tag 810 which consists of antenna 815, battery 820, and chip 830 affixed to a package. The cover (typically 270 of FIG. 2) for the tag is the paper of the stamp. Adhesives,



such as acrylics, are used to sandwich the tag between thin paper. These adhesives would correspond to the layer 250 in FIG. 2. The top surface (of one side 270) can be printed with the appropriate graphics while the bottom surface has a pressure sensitive adhesive (of the other side 270 in the case of a tag laminated on two sides) to bond the stamp to a package.

As another example, Moskowitz et al. disclose an RFID tag in combination with a



passport as shown in FIG. 9 in which a thin RF tag 920 embedded in the cover 910 of passport 930 to form an RF passport 900. Here the tag is sandwiched between the paper covers of the passport. The tag can have an environmental laminate(s) (270) as described above or alternatively, the passport cover can be used as the tag laminate(s) (270).

**FIG. 9**

U.S. Patent No. 5,751,221 to Stanfield et al. shows an electronic filing system. A wireless version is shown in FIG. 15 in which RF transceivers 120 are connected to processor 20 and either to each file folder 70 or to each folder retainer, which refers to tray 40, file cabinet 50, shelving unit 60, and desk drawer 86.

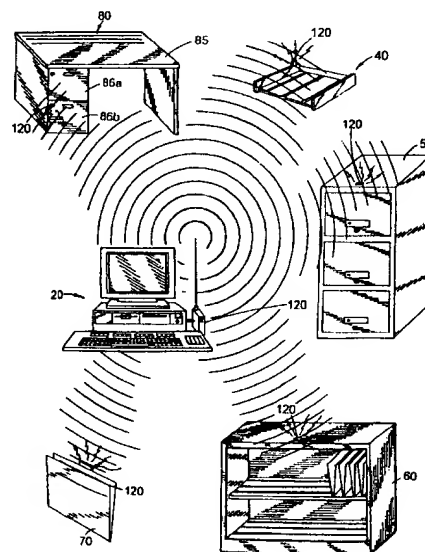


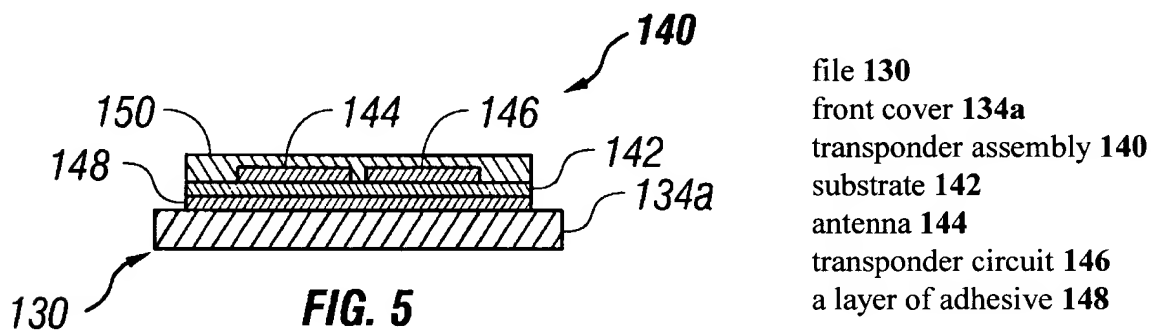
Fig. 15

### Discussion of Claim 1

Neither of the cited patents shows a file as recited in claim 1 which includes a body with a pair of covers and a transponder assembly attached to one of the covers with adhesive. Briefly, claim 1 recites a file including:

a body including a pair of covers; and  
a transponder assembly including ... a substrate [and] ... an adhesive layer ... ;  
the transponder assembly being attached to one of the covers by the adhesive.

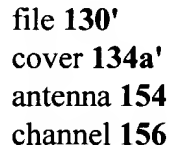
FIG. 5 of the subject application shows an example of the file recited in claim 1, with the claim elements with corresponding reference numerals provided:



The Moskowitz et al. patent shows that an RF ID tag 200 is *sandwiched between thin paper* (see Moskowitz et al., column 6, line 45) as in a postage stamp shown in FIG. 8, *sandwiched between paper covers* 910 of a passport 930 as shown in FIG. 9 as described above, or *sandwiched between paper covers* of an admission ticket 1010 as shown in FIG. 10 (see Moskowitz et al., column 7, lines 6–9). The Stanfield et al. patent shows that an RF transceiver 120 is connected to a file folder 70. Neither the Moskowitz et al. nor Stanfield et al. patent mentions or shows *a transponder assembly with an adhesive layer on a substrate, with the adhesive layer attaching the assembly to a cover*.

Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Patent Office because the cited references do not provide any suggestion on how to combine or modify the references, with the combination or modification being sufficient to render the file of claim 1 obvious to one of ordinary skill in the art. Therefore, it is respectfully submitted that claim 1 is patentable over the Moskowitz et al. and Stanfield et al. patents and is in condition for allowance.

Claim 2 sets forth a file in which an antenna of a transponder assembly is embedded on one of the covers of a body. An example of the file recited in claim 2 is shown in FIG. 7:



In contrast to the file recited in claim 2 in which an antenna is embedded in a cover, the Moskowitz et al. patent shows an RFID tag *sandwiched between paper covers*. The Stanfield et al. patent shows that an RF transceiver connected to a file folder. Neither the Moskowitz et al. nor Stanfield et al. patent mentions a file with an antenna embedded in a cover.

### Claim 3

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### The Cited References

The Moskowitz et al. and Stanfield et al. patents are discussed above. U.S. Patent No. 5,936,527 to Isaacman et al. shows an automatic tag system in FIG. 3 that includes a plurality of RFID tags 20 attached to documents (not shown) whose location is desired to be located/identified at some point in time. A plurality of local exciters 18 are placed on the shelves and drawers in an office. A host transceiver 14 is placed in a central location in the office and transmits a radio frequency signal to the local exciter 18. The local exciter 18 transmits a signal to a plurality of tags 20. Thereafter, if one of the tags 20 is selected, then that tag's response is detected by the host 14.

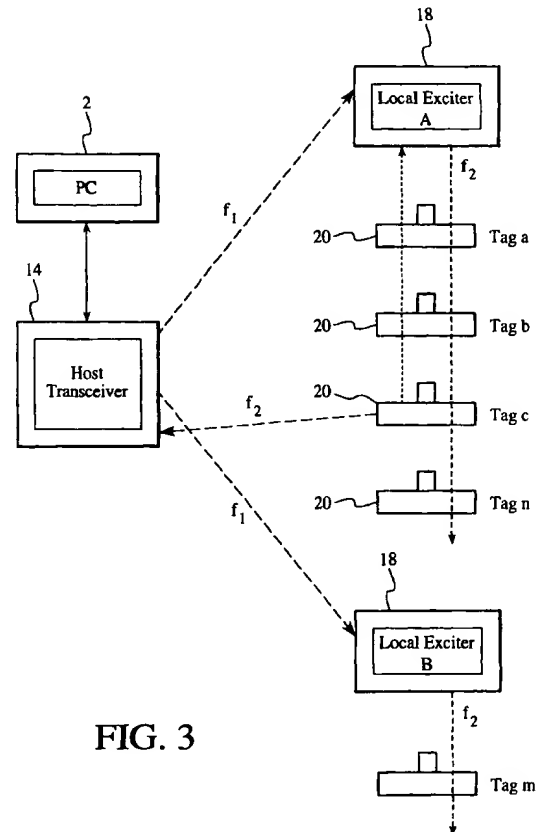


FIG. 3

### Discussion of Claim 3

Claim 3 sets forth a system for tracking objects including a plurality of antenna arrays, a plurality of files, a reader, and an administrator. The files include a transponder assembly attached to a cover by adhesive, analogous to the file of claim 1 discussed above.

As mentioned above, neither of the Moskowitz et al. and Stanfield et al. patents show a file with a transponder attached with adhesive. The Isaacman et al. patent also does not talk about or show attaching a transponder to a file with adhesive.

Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Patent Office because the cited references do not provide any suggestion on how to combine or modify the references, with the combination or modification being sufficient to render the file of claim 3 obvious to one of ordinary skill in the art. Therefore, it is

respectfully submitted that claim 3 is patentable over the Moskowitz et al., Stanfield et al., and Isaacman et al. patents and is in condition for allowance.

### Claim 4

Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,528,222 to Moskowitz et al. Applicant traverses this rejection.

### The Cited References

The Moskowitz et al. patent is discussed above.

### Discussion of Claim 4

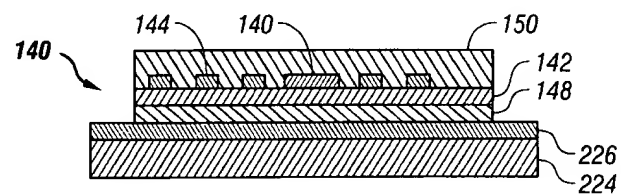
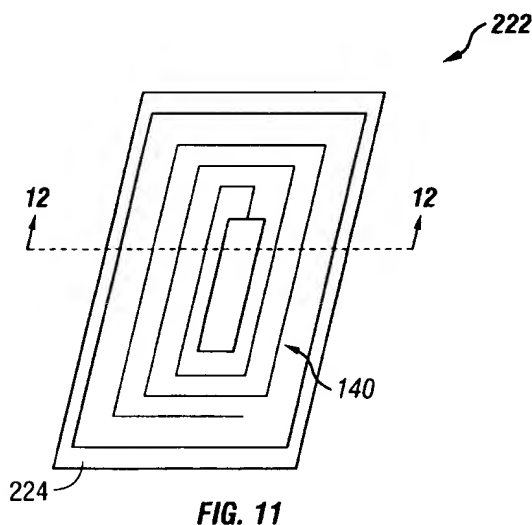
Claim 4 sets forth a label transponder assembly including a transponder assembly and a backing sheet. The transponder assembly includes:

a substrate ...;

**\* \* \***

an adhesive layer disposed on ... the substrate.

The backing sheet is releasably attached to the adhesive layer. An example of the label transponder assembly as recited in claim 4 is shown in FIGS. 11 and 12:



**FIG. 12**

transponder assembly 140

substrate 142

adhesive layer 148

transponder label assembly 222

backing sheet 224

a release layer 226

A user may employ the transponder label assembly of claim 4 in retrofitting objects for tracking by peeling the transponder assembly 140 off of the backing sheet 224 for adhering to an object.

As discussed above, the Moskowitz et al. patent does not show or describe a file with a transponder assembly in the form of a label with adhesive and a backing sheet. Rather, the Moskowitz et al. patent *sandwiches an RFID tag between the paper* of, e.g., a stamp, a passport, or an admission ticket. Thus, in the case of the passport and the admission ticket, there is no need for adhesive when using the Moskowitz et al. RFID tag. And in the cast of a stamp, Moskowitz et al. do not show an adhesive layer on a substrate with a backing sheet.

Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Patent Office because the cited references do not provide any suggestion on how to combine or modify the references, with the combination or modification being sufficient to render the file of claim 4 obvious to one of ordinary skill in the art. Therefore, it is respectfully submitted that claim 4 is patentable over the Moskowitz et al. patent and is in condition for allowance.

#### COMMENTS ON ERRORS OF PATENT OFFICE REJECTIONS

In rejecting claim 1, the Patent Office states that when the Moskowitz et al. tag is embedded in the covers of a passport, that this arrangement “inherently involves adhering via the adhesive 250 to the cover layers/material in the embedded condition.” It is respectfully submitted that this is an errant reading of the Moskowitz et al. patent.

Moskowitz et al. state at column 6, lines 58–63, that either the entire tag shown in FIG. 2 with the laminates 270—each of which includes a hot-melt 250 and a coating 260—may be embedded in the covers of the passport, or that the tag without the laminates 270 may be embedded, with the covers of the passport sandwiching the tag.

In the first laminate-use embodiment, it is impossible for the hot-melt 250 to attach the tag to the covers as the hot-melt 250 is positioned between the tag and the coatings 260. In the second laminate-free embodiment, Moskowitz et al. do not teach that adhesive is used. Therefore, in both embodiments, the only inference that can be made is that the covers retain the entire assembly therein without the use of adhesive. These comments also apply to claim 3.

In rejecting claim 2, the Patent Office states that Moskowitz et al. teach embedding a tag in a cover, which is true. However, claim 2 recites that the transponder assembly is disposed *on*, not *in*, a cover.



In rejecting claim 4, the Patent Office States when the transponder of Moskowitz et al. “is applied to a postage stamp, the bottom surface of the transponder has pressure sensitive adhesive to bond the stamp to a package.”

However, Moskowitz et al. talk about at column 6, lines 44 and 45, that adhesives are used to sandwich the tag between thin paper. This arrangement is not what is recited in claim 2. To further highlight this structural difference, new claim 18 has been added, as discussed below.

#### NEW CLAIMS

New claims 5–20 have been added to more particularly point out and distinctly claim the subject matter which applicant regards as the invention. Support for the new claims may be found, for example, in paragraphs 0037–0041 and FIGS. 5–8.

New claims 5–15 respectively depend from claims 1–4. New claims 16 and 18 are independent claims, with claims 17, 19, and 20 respectively depending thereon. New claim 16 highlights the embodiment shown in FIG. 6 and discussed in paragraph 0040. New claim 18 is directed to a label that consists of a transponder assembly and a backing sheet.

For reasons analogous to those presented above, it is respectfully submitted that new claims 5–20 are patentable and in condition for allowance.

**CLOSING COMMENTS**

In view of the foregoing remarks, it is respectfully submitted that the subject application, including claims 1-4, is in condition for allowance. Early notification of the same is respectfully requested.

The Examiner is invited to contact the undersigned if he believes there are any issues which may remain preventing the allowance of the claims and the passage of the application to issue.

Respectfully submitted,

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Eric K. Satermo  
Registration No. 40,159

17744 Skypark Circle, Suite 295  
Irvine, California 92614  
Telephone: (949) 752-9525  
Facsimile: (949) 752-5585